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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Terry Pullaro	
Serial No.: 10/810,347	Group No.: 3711
Filed: March 26, 2004	Examiner: Alvin A. Hunter
For: SPORTS TRAINING AND CONDITIONING DEVICE	

St. Louis, Missouri
Date: February 11, 2008

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
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TRANSMITTAL OF AMENDED APPELLANT'S BRIEF ON APPEAL (PATENT APPLICATION 37 CFR 41.37)

1. Transmitted herewith is the AMENDED APPELLANT'S BRIEF ON APPEAL in this application in response to the Non-Compliant Appeal Brief dated January 9, 2008.

2. STATUS OF APPLICANT

This application is on behalf of:

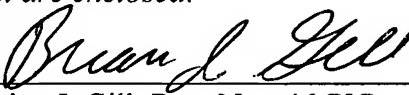
- ☐ other than a small entity
☒ small entity

Small entity status:

- ☒ is claimed.
☐ is NOT claimed.

3. FEE DEFICIENCY

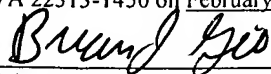
The Commissioner is hereby authorized to charge any additional fees or credit overpayment under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account 162201. *Duplicate copies of this sheet are enclosed.*



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Appl. No.	:	10/810,347
Applicant	:	Terry Pullaro
Filed	:	March 26, 2004
Title	:	SPORTS TRAINING AND CONDITIONING DEVICE
TC/A.U.	:	3711
Examiner	:	Alvin A. Hunter
Conf. No.	:	8229
Docket No.	:	PULT 9283US

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Assistant Commissioner of Patents
Alexandria, VA 22313-1450

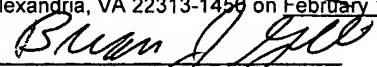
AMENDED APPELLANT'S BRIEF ON APPEAL (37 CFR 41.37)

This brief is in furtherance of the Notice of Appeal filed in this case on July 11, 2007 and in response to the Notice of Non-Compliant Brief of January 9, 2008. This Appeal Brief is amended to place the Claim-Appendix, the Evidence Appendix and the related Proceedings on separate pages. Additionally, this Appeal Brief is amended to note the claim identifiers for the claims in the Claims Appendix.

The fees required under § 41.20(b)2) and any required petition for extension of time for filing this amended Appeal Brief and fees therefore are noted in the accompanying TRANSMITTAL OF APPEAL BRIEF.

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Brian J. Gill, Reg. No. 46,727

This brief contains these items under the following headings and in the order set forth below (37 CFR 41.37(c)):

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED
- VII. ARGUMENT
- VIII. CLAIMS APPENDIX
- IX. EVIDENCE APPENDIX
- X. RELATED PROCEEDINGS APPENDIX

I. REAL PARTY IN INTEREST (37 C.F.R. 41.37(c)(1)(i))

The real party in interest in this appeal is the named inventor, Terry J. Pullaro.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R.41.37(c)(1)(ii))

With respect to other appeals or interferences that will directly affect, or be directly affected by, or having a bearing on the Board's decision in this appeal:

- A. ☒ there are no such appeals or interferences.
- B. ☐ there are as follows:

III. STATUS OF CLAIMS (37 CFR 41.37(c)(1)(iii))

Under 37 C.F.R. 41.37(c)(1)(iii), claims 1 and 4-14 are rejected and claims 2, 3 and 15-17 are cancelled. Claims 1 and 4-14 are the claims appealed.

IV. STATUS OF AMENDMENTS (37 CFR 41.37(c)(1)(iv))

Subsequent to the final rejection of April 11, 2007, a response was mailed on July 11, 2007, proposing an amendment to claim 1 in view of the Examiner's comments and apparent misunderstanding of the invention as expressed in the final rejection. However, the Examiner refused entry of the amendment in an advisory action of July 24, 2007. Hence, this appeal is proceeding without entry of that amendment.

V. SUMMARY OF CLAIMED SUBJECT MATTER (37CFR 41.37(c)(1)(v))

The invention is directed to a sport-specific training and conditioning device for a sport using a hand-held implement having a grip portion. (See: Specification p. 3, lines 9-12; Fig. 1, #20). As explained in the specification and shown in the figures, the device comprises a handle shaped like the grip portion of the implement having first and second ends. (See: Specification p. 3, lines 12-14; Figs. 1-3, 6, #24 and #26). The device further comprises a single uniformly shaped weight that is internally fastened with the second end of the handle while the first end of the handle remains weight free such that the internal fastening of the uniformly shaped weight with the second end fastens the uniformly shaped weight to a normally non-rotatable position. (See: Specification

p. 4, lines 1, 22-24; Figs. 1-6, #28; p. 5, lines 1-5, 6-14). A center of mass of the device is positioned within the uniformly shaped weight and the center of mass is less than about thirteen inches from the first end of the handle. (See: Specification p. 4, lines 5-6). The handle has a circumference sized between about ten and about thirty percent larger than the grip portion of the hand-held implement and has a length that is longer than the uniformly shaped weight wherein the positioning of the uniformly shaped weight. (See: Specification p. 5, lines 1-4; Fig. 6, #102). The sizing of the circumference of the handle and the positioning of the center of mass are configured to direct the effect of the uniformly shaped weight in a concentrated manner to the forearms of the user during exercise with the device. (See: Specification p. 10, lines 22-26).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (CFR

41.37(c)1)(vi))

Claims 1 and 6-14 have been rejected by the Examiner under 35 U.S.C. §103(a) as being allegedly unpatentable over the "Smith reference" (U.S. Patent No. D241,958) in view of the "Huffman reference" (U.S. Patent No. 5,215,307) and the "Piccini reference" (U.S. Patent No. 4,378,113) further in view of the "Spivey reference" (U.S. Patent No. 4,272,077). Claims 4 and 5 have been rejected by the Examiner under 35 U.S.C. §103(a) as being allegedly unpatentable over the prior art applied in claim 1 in view of the "Hart reference" (U.S. Patent No. 6,379,261).

VIII. ARGUMENT (CFR 41.37(c)(1)(vii))

Rejection of Claims 1 and 6-14 Under 35 U.S.C. § 103(a)

For the purposes of this appeal, all of the claims can be considered as a single group, with independent claim 1, the single independent claim in the application, being representative of the group. While the dependent claims introduce elements not suggested by the cited prior art, to reduce the issues of the main issue, only claim 1 is considered.

As indicated above, the Examiner has rejected claim 1 under 35 U.S.C. §103(a) as being allegedly obvious in view of the cited prior art. The law of obviousness has been clear for generations: "The mere fact that elements of [an invention] may be found in various [references] does not necessarily negate invention." *In re McKenna*, 40 C.C.P.A. 937, 203 F.2d 717, 721, 97 U.S.P.Q. (BNA) 348, 351 (CCPA 1953). It is respectfully suggested that the Examiner here improperly has constructed a rejection with hindsight based merely on the road map provided by Applicant's specification. As the Federal Circuit has admonished, "virtually all [inventions] are combinations of old elements." *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed. Cir. 2005). What the Examiner apparently has attempted to do is to find every individual element of the claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.

To counter this propensity to construct an obviousness rejection, the suggestion to combine the art stands as a safeguard against hindsight analysis

and rote application of the legal test for obviousness. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." M.P.E.P §2143.01(I) (Citations omitted)

The recent *KSR* case (*KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. April 30, 2007)) is not believed to have altered the requirements. (See: attached U.S.P.T.O Memorandum). As outlined in the U.S.P.T.O Memorandum, the Court in *KSR* reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. §103(a). Under the *Graham* decision, these factors include: (a) determining the scope and contents of the prior art; and (b) ascertaining the differences between the prior art and the claims in issue. *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966).

As noted in the May 3, 2007 U.S.P.T.O. Memorandum, the *KSR* Court "recognized that a showing of 'teaching, suggestion, or motivation' to combine prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. 103(a)." (See: U.S.P.T.O. Memorandum)(Emphasis added.) Further, as outlined in this U.S.P.T.O. Memorandum, the *KRS* Court noted that the "analysis

supporting a rejection under 35 U.S.C. § 103(a) should be made explicit and that it was 'important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] element'" in the manner claimed. The Court specifically stated:

"Often, it will be necessary ...to look at interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, the analysis should be made explicit."

KSR, slip op. at 14.

The U.S.P.T.O. Memorandum concludes in its current analysis of the *KSR* decision that "in formulating a rejection under U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed".

Viewed in this light, the Examiner's rejection is clearly erroneous. The Smith reference is particularly deficient. As a design patent, nothing is known about the device except for the way the device looks. Even then, the design element appears to be a V shaped structure shown in Figure 1. Applicant calls the Examiner's attention to the fact that the title of the design is "Golf Swing Practice Club." Nothing in that title even vaguely suggests a conditioning device in the context of Applicant's invention. But the Examiner has made the Smith reference the primary reference.

The Huffman reference cannot properly be combined with the Smith reference, if the Smith reference, for the purposes of argument, has some meaning not evident on the face of the design as applied by the Examiner, because the Huffman reference specifically teaches away from the Smith reference. The Smith reference shows a structure at one end (and because the Smith reference is a design patent, it is not clear what that structure is). Assuming for the sake of argument that the structure is some form of weight, the combination being made by the Examiner is improper. The problem that the Huffman reference allegedly solves is, as stated at Column 1, lines 19-22: "What is needed is a weighted exercise device that will allow the user to practice the specific swing of a given sport such as golf, tennis or baseball but not affect the balance of the user while performing the exercise." The two concepts are mutually exclusive, and the combination made by the Examiner is respectfully suggested to be erroneous.

The Huffman reference teaches a training exercise method. The method provides a normal balance to the user while the user swings a counter weighted device. (See: Abstract)(Emphasis added). The device includes a shaft with weights at opposing ends that counter balance each other. In the Background Section, the Huffman reference discloses that a training device having a weight at only one end of a training device results in the disadvantage of pulling the user toward the weight. (See: Col. 1, lines 10-11).

Furthermore, the Huffman reference discloses that a need exists for an exercise method that does not affect the balance of the user while performing the

exercise. (See: Col., lines 20-21). In fact, the Huffman reference states that the "key is the counter balanced weights at opposite ends of the shaft with one of the weights being between the hands on the grip and the user's body." (See: Col. 2, lines 54-57)(Emphasis added). In contrast, the Smith reference teaches a single structure at one end.

Applicant's claim 1 recites that the positioning of the non-rotatable weight, the positioning of its center of mass and the sizing of the handle circumference are configured to direct the effect of the weight in a concentrated manner to the forearms of the user. In other words, the single weight of the present application results in an unbalanced force in order to direct the concentration of the effect of the weight to the user's forearm. Furthermore, in order to concentrate the effect of the weight to the user's forearm, the weight must be at the end of the shaft. As such, the weight of the present application is not positioned between the user's hand and the user's body as taught and emphasized by the Huffman reference.

Since the present application uses a single weight at the end of the shaft to provide an unbalanced weight, one skilled in the art would not be motivated to seek out the Smith reference and combine it with the Huffman reference due to the required balanced weights and the stated objectives of the Huffman reference.

The Piccini reference likewise is deficient. First, it also teaches away from the claimed invention in that it has variable weights. Second, it is exercise specific, stating at column 1, 9-11, that "[t]his invention relates to warm-up exercises for athletes and more particularly to wrist warm-up exercises for

baseball players. " Applicant's claim 1 as presently presented also is exercise specific, but the exercise specific structure required by claim 1 (and not shown in the art) applies to the forearms, not the wrists. That is not a distinction without a difference, in that in many sports, it is the forearm that requires strengthening.

In particular, the Piccini reference teaches method of warming up wrists by manipulating a club-like implement having a truncated handle and a body. (See: Column 2, lines 4-6). The body includes a sloping hollow chamber that is partially filled with water. (See: Column 2, lines 6-8; Fig. 2). The implement has an abbreviated handle to prevent the athlete from grasping the implement in the same manner that he would grasp a baseball bat or golf club. (See: Column 2, lines 19-23) (Emphasis added). As taught by the Piccini reference, "[b]y providing the abbreviated handle portion, the inventor has provided a device which deliberately makes no effort to simulate the feel of an actual athletic implement." (See: Column 3, lines 11-13) (Emphasis added).

In contrast, Applicant's claim 1 recites that the handle is shaped like the grip portion of the implement. As noted, the Piccini reference deliberately makes no effort to simulate the feel of an actual athletic implement. Furthermore, claim 1 recites that the weight's shape, the sizing of the circumference of the handle and the positioning of the center of mass are configured to direct the effect of the weight in a concentrated manner to the forearms of the user. (Emphasis added).

The Spivey reference is even more remote, and truly demonstrates that the Examiner has used Applicant's specification to combine unrelated pieces of prior art, having little or no relationship to Applicant's structural combination to fashion

an improper rejection. The Spivey reference is a "Golf Club Putter Grip." The whole purpose of the Spivey reference is to improve the user's putting by "minimizing putter jerks or yips by preventing the non-dominant hand from overriding the dominant hand." (See: Abstract). This reference uses a formula determined by hand sizes that forces the grip of the non-dominant putting hand to be in a relaxed position so that it does not pull against the putting motion of the dominant hand. (See: Column 1, lines 31-34). As shown in Figs. 4 and 5, a measurement of the golfer's hand is taken to size the distance between the tip of the index finger and the metacarpo phalangeal joint. This measurement is used to determine the circumference of the golf putter grip. (See: Column 2, lines 55-68). By having the non-dominant hand around this sized grip, the non-dominant hand is in the as near as possible relaxed position. (See: Column 3, lines 25-30)(Emphasis added). During use, the dominant hand of the golfer grips the putter tightly while muscles in the non-dominant hand remain relaxed.

The Spivey reference is not concerned with any of the problems overcome by Applicant's device or the structural combination as a whole of Applicant's claim 1. In contrast, Applicant's claim 1 recites that positioning of the normally non-rotatable weight and the handle circumference direct the effect of the weight in a concentrated manner to the forearms of the user. In other words, both forearms of the user are flexed (i.e., non-relaxed as stated in the Spivey reference).

35 U.S.C 103(a) still requires "[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of

this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” It is respectfully suggested that the Examiner has only paid lip service to the requirement concerning the “subject matter as a whole” language of the statute. Nothing in the art of record shows describes or even vaguely intimates the “subject matter as a whole” of Applicant’s structural combination set forth in the claim 1. Rather, apparently using Applicant’s specification as a guide, the Examiner has improperly constructed the rejection element by element. Furthermore, under this improper construction, the Examiner’s rejections are silent as to why a person of ordinary skill in the art would have combined the references as the manner claimed.

VIII. CLAIMS APPENDIX (37 CFR 41.37(c)(1)(viii))

The text of the claims in the appeal is:

1. (Previously Presented) A sport-specific training and conditioning device for a sport using a hand-held implement having a grip portion, the device comprising a handle shaped like the grip portion of the implement, the handle having first and second ends, the device further comprising a single uniformly shaped weight that is internally fastened with the second end of the handle while the first end of the handle remains weight free such that the internal fastening of the uniformly shaped weight with the second end fastens the uniformly shaped weight to a normally non-rotatable position and such that a center of mass of the device is positioned within the uniformly shaped weight and the center of mass is less than about thirteen inches from the first end of the handle, the handle having a circumference sized between about ten and about thirty percent larger than the grip portion of the hand-held implement and the handle having a length that is longer than the uniformly shaped weight wherein the positioning of the uniformly shaped weight, the sizing of the circumference of the handle and the positioning of the center of mass are configured to direct the effect of the uniformly shaped weight in a concentrated manner to the forearms of the user during exercise with the device.

2. (Cancelled)

3. (Cancelled)

4. (Previously Presented) The sport-specific training and conditioning device according to claim 1 wherein the uniformly shaped weight has a diameter of less than about 4 inches.

5. (Previously Presented) The sport-specific training and conditioning device according to claim 1 wherein the uniformly shaped weight has a length of less than about 4 inches.

6. (Previously Presented) The sport-specific training and conditioning device according to claim 1 wherein the device weights more than the hand-held implement used in the sport.

7. (Previously Presented) The sport-specific training and conditioning device according to claim 1 wherein one of the handle and the uniformly shaped weight includes an externally threaded portion, and wherein the other of the handle and the uniformly shaped weight includes an internally threaded socket.

8. (Previously Presented) The sport-specific training and conditioning device according to claim 7 wherein the handle includes an externally threaded portion and the uniformly shaped weight includes an internally threaded socket.

9. (Previously Presented) The sport-specific training and conditioning device according to claim 1 wherein the handle is shaped like the grip portion of a bat.

10. (Previously Presented) The sport-specific training and conditioning device according to claim 1 wherein the handle is shaped like the grip portion of a racket.

11. (Previously Presented) The sport-specific training and conditioning device according to claim 10 wherein the grip is shaped like the grip portion of a tennis racket.

12. (Previously Presented) The sport-specific training and conditioning device according to claim 1 wherein the handle is shaped like the grip portion of a golf club.

13. (Previously Presented) The sport-specific training and conditioning device according to claim 1 wherein the handle is like the grip portion of a hockey stick.

14. (Previously Presented) The sport-specific training and conditioning device according to claim 1 wherein the handle is less than about 10 inches long.

15. (Cancelled)

16. (Cancelled)

17. (Cancelled)

IX. EVIDENCE APPENDIX

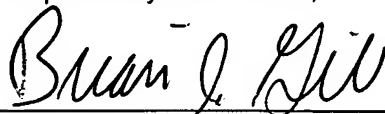
U.S.P.T.O MEMORANDUM dated May 3, 2007

Smith	DUS 241,958
Huffman	US 5,215,307
Piccini	US 4,272,077
Hart	US 6,379,261

XI. RELATED PROCEEDINGS APPENDIX

None.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brian J. Gill". The signature is written in a cursive, flowing style. Below the signature is a horizontal line.

Date: February 11, 2008

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MEMORANDUM

DATE: May 3, 2007

TO: Technology Center Directors

FROM: *Margaret A. Focarino*
Margaret A. Focarino
Deputy Commissioner
for Patent Operations

SUBJECT: Supreme Court decision on *KSR Int'l. Co., v. Teleflex, Inc.*

The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l. Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourt.us/opinions/06pdf/04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

- (1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:
- (a) determining the scope and contents of the prior art;
 - (b) ascertaining the differences between the prior art and the claims in issue;
 - (c) resolving the level of ordinary skill in the pertinent art; and
 - (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

- (2) The Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

- (3) The Court rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. The Court specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be **made explicit**.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.